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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,885	07/23/2003	Andrew Wells Phelps	UVD 0279 IA/UD 267	3049

7590 09/21/2005

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EXAMINER

HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,885

Applicant(s)

PHELPS ET AL.

Examiner

Patricia L. Hailey

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 23, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/23/03, 08/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. *Claim 1-5, 8-41, 43, 46-52, 55-58, and 61-67 are of copending. provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9-43, 50-61, and 68-73 of copending Application No. 10/625,915.*

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are directed to a corrosion-inhibiting pigment comprising a rare earth element and a valence stabilizer combined to form a rare earth/valence stabilizer complex, whereas the claims in the '915 application are directed to a corrosion-inhibiting coating material, also comprising a rare earth element and a valence stabilizer combined to form a rare earth/valence stabilizer complex.

Aside from the phrases "corrosion-inhibiting pigment" and "corrosion-inhibiting

coating material”, the respective sets of claims are identical, regarding the rare earth element, the valence stabilizer, as well as the remaining claims listed above. One having ordinary skill in the art would find reasonable expectation that the instantly claimed corrosion-inhibiting pigment could function as a corrosion-inhibiting coating material, given that the pigment and coating material are defined using the same claim limitations. Additionally, the term “pigment” is well known in the art as an example of a “coating material”.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. *Claims 1-5, 8-41, 46-52, 55-58, 61-67, 77, 84-90, and 102-104 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-41, 56-67, 74-79, 91, 108, 117, 121-125, and 137-139 of copending Application No. 10/625,886.*

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are directed to a corrosion-inhibiting pigment comprising a rare earth element and a valence stabilizer combined to form a rare earth/valence stabilizer complex, whereas the claims in the ‘915 application are directed to a corrosion-inhibiting seal, also comprising a rare earth element and a valence stabilizer combined to form a rare earth/valence stabilizer complex.

Aside from the phrases “corrosion-inhibiting pigment” and “corrosion-inhibiting seal coating material”, the respective sets of claims are identical, regarding the rare

earth element, the valence stabilizer, as well as the remaining claims listed above. One having ordinary skill in the art would find reasonable expectation that the instantly claimed corrosion-inhibiting pigment could function as a corrosion-inhibiting seal, given that the pigment and the seal are defined using the same claim limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Askew et al. (U. S. Patent No. 5,226,956).

Askew et al. teach a paint or varnish composition comprising a medium, and an anticorrosion agent that is environmentally non-hazardous, soluble, or adapted to be soluble in said medium. See the Abstract of Askew et al.

The paint or varnish composition can be applied to metal substrates such as iron, steel, copper, aluminum, zinc, and magnesium. See col. 1, lines 11-14 of Askew et al.; this disclosure is considered to read upon Applicants' claims regarding the "method for treating a surface for corrosion resistance" (e.g., claim 77).

Examples of the anticorrosion agent include compounds or complexes that are solubilized by various techniques, such as by modification to add moieties such as an ester group, a glycol, an alkoxy group, etc., e.g., tetraethylene pentamine, triethylene tetraamine, phenoxyacetic acid, tertiary butylaniline, carboxylic or aromatic acids, organosulfur compounds, organonitrogen compounds including organic derivatives of various nitrogen aids, optionally thio-substituted, organophosphorus compounds,

heterocyclic compounds, etc. See col. 2, lines 12-54 of Askew et al.; this disclosure is considered to read upon the claim limitation "valence stabilizer" (e.g., claim 13), as well as the claim limitation "solubility control agent" (e.g., claim 64).

Additionally, the paint or varnish composition may contain driers, such as metal-containing organic compounds or compositions, such as those of cobalt, manganese, calcium, barium, lead, or rare earth metals such as cerium, often combined with carboxylic acids. See col. 2, line 64 to col. 3, line 8. This disclosure is considered to read upon the claim limitation "rare earth element", as well as the "additional ion" (e.g., claim 9).

Askew et al. do not explicitly teach the claimed properties of the "corrosion-inhibiting pigment". However, because this reference teaches components comparable to that respectively claimed, it would have been obvious to one skilled in the art at the time the invention was made to reasonably expect that the paint or varnish composition of Askew et al. would exhibit these claimed properties in comparable values, absent the showing of convincing evidence to the contrary.

Conclusion

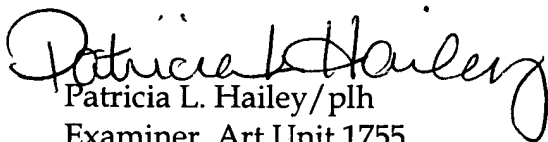
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patricia L. Hailey/plh
Examiner, Art Unit 1755
September 19, 2005


KARL GROUP
PRIMARY EXAMINER
GROUP 1755